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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,685	02/08/2002	Will Crosby	13822-002001	2083
26161	7590	04/08/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			HIRL, JOSEPH P	
			ART UNIT	PAPER NUMBER
			2129	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/071,685	Applicant(s) CROSBY ET AL.	
	Examiner Joseph P. Hirl	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>A, B</u> . | 6) <input type="checkbox"/> Other: _____ |

File

DETAILED ACTION

1. Claims 1-30 are pending in this application.

Drawings

2. The drawings are objected to because of the following:

Fig. 5, item 86, change "Chack" to -Check--.

This objection must be corrected.

Specification

3. The specification is objected to for the following:

MPEP 608.01(i), 37CFR 175 (h) requires that all matters related to claims must commence on a separate page. Applicant's claims commence on page 21 which also contains non claim matter.

This objection must be corrected.

Information Disclosure Statement

4. The information disclosure statement filed May 15, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A web site is not a document (AQ). The full document related to Benjamin Hollister et al must be provided (AR).

Claim Objections

4. Claims 2, 12 and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Social responsibility is a very general term as indicated by the applicant's discussion on page 1, lines 16-20 and can be envisioned to cover "whatever". Hence the related claims cannot be limiting on the related independent claim.

5. Claims 8, 18 and 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. The term best is relative, the related claims are indefinite and therefore such claims cannot properly limit the related independent claims.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 12 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Social responsibility is a very general term as indicated by the applicant's discussion on page 1, lines 16-20 and can be envisioned to cover "whatever". Hence the related claims are without limits and therefore indefinite.
8. Claims 8, 18 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "best" is a relative term and reduces the claim to the level of being indefinite.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Albeit a trivial application, the subject claims can be implemented using pencil and paper. This rejection can be overcome by inserting the term "computerized" prior to the term "method" in the preamble of claim 1.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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12. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Geller et al (U.S. Patent 6,536,990, referred to as **Geller**).

Claims 1, 11, 21

Geller anticipates displaying a set of categories, each category having a set of weights for a user to choose, each item being associated with the set of categories (**Geller**, c 2, l 18-37; c 2, l 64-67; c 3, l 1-26); and displaying a search result based on the weights chosen by the user, the search result including a ranking of the items (**Geller**, c 2, l 18-37; c 2, l 64-67; c 3, l 1-26).

Claims 2, 12, 22

Geller anticipates each category as an area of social responsibility (**Geller**, c 2, l 18-37; Examiner's Note (EN): para 16 applies; social responsibility is a generic term to which almost any subject appropriately applies in some fashion).

Claims 3, 13, 23

Geller anticipates displaying a set of factors for each category when selected by the user, each factor capable of being chosen by the user (**Geller**, c 2, l 18-37; EN: para 16 applies; attributes are factors); and collating the categories weighted by the user, the factors chosen by the user, and a product chosen by the user (**Geller**, c 2, l 18-37).

Claims 4, 14, 24

Geller anticipates selecting a list of companies that have the product (**Geller**, c 2, l 18-37; c 3, l 34-44); and determining a rating for each company based on the categories weighted by the user and the factors chosen by the user (**Geller**, c 2, l 18-37).

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Claims 5, 15, 25

Geller anticipates finding a set of brands associated with the product (**Geller**, c 2, l 18-37; c 3, l 34-44); and finding the company associated with each brand (**Geller**, c 2, l 18-37; c 3, l 34-44).

Claims 6, 16, 26

Geller anticipates displaying a search result comprises displaying the search result based on the factors chosen by the user (**Geller**, c 2, l 18-37).

Claims 7, 17, 27

Geller anticipates displaying a search result comprises ranking the brands on a five-star scale, the five-star scale including a one-star rating, a two-star rating, a three-star rating, a four-star rating, and a five-star rating (**Geller**, c 7, l 50-67; c 8, 1-8; EN: para 16 applies; the applicant's scale of five is equivalent to Geller's scale of irrelevant to critical).

Claims 8, 18, 28

Geller anticipates using the five-star rating as the best rating of the ratings determined (**Geller**, c 7, l 50-67; c 8, 1-8; EN: claim is evaluated without the use of the term "best" since such term is indefinite).

Claims 9, 19, 29

Geller anticipates receiving information from an external database (**Geller**, c 2, l 18-37); and quantifying the data on a scale (**Geller**, c 2, l 18-37).

Claims 10, 20, 30

Geller anticipates displaying a search result comprises displaying a ranking of companies (**Geller**, c 2, l 18-37; EN: preferences can be changed and ranks recalculated).

Examination Considerations

13. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

14. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and

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unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

15. Unless otherwise annotated, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

16. Examiner's Opinion: Paras 13.-15. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

17. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Chang et al, U.S. Patent 5,321,833
- Takechi, U.S. Pub 2002/0004758
- Burrows, U.S. Patent 5,765,150
- Siegel, JR. et al, U.S. Pub 2002/0032629
- Keyes et al, U.S. Pub 2002/0116309
- Eder, U.S. Patent 2001/0034686

18. Claims 1-30 are rejected.

Correspondence Information

19. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

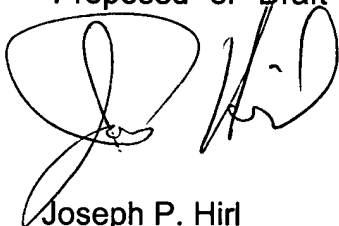
or faxed to:

(703) 872-9306 (for formal communications intended for entry);

or faxed to:

(571) 273-3685 (for informal or draft communications with notation of

"Proposed" or "Draft" for the desk of the Examiner).

A handwritten signature in black ink, appearing to read 'J. P. Hirl', is written over a horizontal line.

Joseph P. Hirl

March 30, 2005